

**REMARKS/ARGUMENTS**

***The Final Office Action***

In the above-mentioned Final Rejection, claims 181-186, 188-194, 197-212, 214-234, 236-264, and 269-271 were rejected as being anticipated by U.S. Patent 6,380,132 (Mihara). In response thereto, claims 201, 204, 237, 256 and 269-271 have been amended so that the claims have consistent spelling of words and consistent punctuations. These amendments do not broaden the claims nor have they been made for patentability purposes. New dependent claim 272 has been added. No new matter has thereby been added, Applicant respectfully contends.

***Examiner Ahmad's Claim Construction Technique is Improper***

In the Final Rejection, Examiner Ahmad accorded no patentable weight to any of the phrases listed below because they allegedly "do not affect the structure of the claimed product" and/or because they allegedly "are directed to an intended use of the claimed product structure." He did not provide any analysis or identify the specific facts as to why they allegedly do not "affect the structure" or why they are allegedly "directed to an intended use of the claimed product structure" Accordingly, this is an improper claim construction technique, Applicant continues to contend.

The phrases at issue are: "being constructed and adapted to cause ... to split ..." (claim 181); "... being selected and constructed, and the cut lines being configured, such that ... to split ..." (claim 200), and "... being structurally capable of causing ... to split ... (claims 223 and 242).

No explanation was provided in Examiner Ahmad's rejections as to why these claimed features do not structurally limit the claims. For example, if a sheet structure splits when bent that is certainly a structural limitation or feature of that sheet structure, and is to be distinguished from a sheet structure which does not split when bent. Whether the sheet structure splits when bent is dependent on a number of structural features of the sheet structure, as would be understood by those

skilled in the art, and as explained in the section below relative to Dr. Ugolick's Declaration. Applicant continues to contend that the claimed features are not "intended use, do-not-affect-the-structure limitations." An example of such "an intended use, do not affect the structure limitation" would be if Applicant had claimed: "A sheet structure adapted for use in business transactions, comprising: a first layer ..." Such is definitely not the case here.

***Declaration of Dr. Ugolick Dated 02/15/2007***

Dr. Ugolick in his Declaration analyzed each of the phrases at issue above, and he concluded that each was a structural limitation. He further explained in detail why they were structural limitations because they "depend on many if not all of at least the following structural features, as would be apparent to those skilled in the art: below including one or more of the following: (a) depth of the cut line; (b) width of the cut line; (c) the material of the breakable layer; (d) the properties of the paper layer; (e) the thickness of the breakable layer; (f) if any adhesive is used, the properties of the adhesive; and (g) the depth of the penetration, if any, of the cut line into the breakable layer."

Dr. Ugolick discussed Mihara *et al* in paragraph 11 of his Declaration which is copied below.

11. Mihara *et al.* does not describe a construction which splits, divides or separates into attached first and second layer portions when folded, and specifically when folded or bent upwardly only once or downwardly only once. Cut 2 of Mihara is provided to separate the adhesive label 9 from the release sheet 5. (See Abstract; col. 3, lines 18-21; col. 3, lines 49-54; and col. 5, lines 50-55.) In fact, Mihara *et al.* does not want the release sheet 5 to break or split at the cuts 2 as this would make it more difficult to initiate removal of the labels from the release sheet by separating an easily graspable portion of the label from the release sheet. That is, users want to be able to easily grasp and peel off a unitary predefined sheet adhesive sheet portion or label without fracturing the release sheet in a Mihara *et al.* type of construction. If a portion of the release sheet were to crack and break off and remain adhered to the label, it would defeat the purpose of the Mihara cuts 2, which is to facilitate removal of the labels from the release sheet.

Examiner Ahmad did not analyze or apparently even seriously consider Dr. Ugolick's Declaration. Rather, he essentially ignored it in his Office Action dated May 3, 2007. On page 6, he said "[t]he Declaration of Dr. Ugolick is only directed to the method of sing [sic] the product language and fails to distinguish the instant claimed product from the prior art." On page 7 he said that Dr. Ugolick's Declaration was "ineffective to overcome the prior art of Mihara" because the phrases were directed to intended uses. In other words, Examiner Ahmad simply repeated his prior conclusion without even providing short comments on Dr. Ugolick's claim interpretation and Mihara interpretation. Such treatment is improper, Applicant respectfully contends.

***Examiner Ahmad's Treatment of Applicant's Prior Citation and Discussions of Cases***

Applicant on pages 15-20 of his Amendment dated November 2, 2007 provided Examiner Ahmad with very detailed citations and analyses of case law and Board decisions to explain Applicant's position and to refute Examiner Ahmad's claim construction technique. Examiner Ahmad summarily ignored these citations and analyses. He in effect said that the logic and the holding and the reasons of the Board decisions were not relevant because those decisions were "not directed to label sheet constructions." He further said that the *Hoffer* and *Minton* cases were "not directed to [claim] language at issue." He did not consider or apply the logic, holdings and reasonings of the decisions, but at most looked to see whether identical claim language was used and if not, dismissed the decisions as irrelevant. Clearly, this is improper legal analysis.

Set forth in the sections of this paper below are detailed discussions of how Examiner Ahmad's claim construction "technique" is contrary to the CCPA/Federal Circuit case law, PTO Board Decisions, the MPEP and the practice of other USPTO examiners.

**A. Examiner Ahmad's Technique is Contrary to CCPA/Federal Circuit Case Law**

In *In re Hutchinson*, 154 F.2d 135 (CCPA 1946), the claim language was for a laminated article adapted for use in making a template or the like. That case is not on point herein for the reasons set forth below.

First, it is noted that the *Hutchinson* claim language is in the preamble of the claim, while the claim language at issue in the subject application is in the body of the claim.

Second, the *Hutchinson* claim language states potential uses for and not properties of the claimed material. In contrast, the claim language at issue in the subject application describes properties of the material. Referring to the hypothetical which Applicant's counsel and Applicant's technical representative (Dr. Ugolick) discussed with the Examiner at an earlier personal interview in another application, the claim language at issue here is not "[a] sheet of business cards adapted for use in business transactions, comprising ..." where according to *Hutchinson* the language "adapted for use in business transactions" would not constitute a limitation in any patentable sense.

Third, a discussion of the state of the law beyond the 1946 CCPA *Hutchinson* decision follows. It will be readily apparent therefrom that Examiner Ahmad's claim construction technique is improper.

Again, the claim language at issue in the present application is not in the preamble, but rather in the body of the claim. However, even if it were in the preamble, there is no *per se* rule that it is not accorded patentable weight. Rather it is "a matter to be determined on the facts of each case in view of the claimed invention as a whole." *In re Stencel*, 828 F.2d 751, 754 (Fed.Cir. 1987).

For example, the preambular phrase "an abrasive article" was held to introduce a material limitation in *Kropa v Robie, et al.*, 187 F.2d 150 (CCPA 1951).

The composition of matter claim at issue in *In re Swinehart, et al.* 439 F.2d 210 (CCPA 1971) included in its body (not in its preamble) the phrase "transparent to infrared rays." The Examiner and the Board held in rejecting the claim that the claim was improperly functional. In its decision reversing the Board, the Court of Customs and Patent Appeals said:

We are convinced that there is no support, either in the actual holdings of prior cases or in the statute, for the proposition, put forward here, that 'functional' language, in and of itself, renders a claim improper. We have also found no prior decision of this or any other court which may be said to hold that there is some other ground for objecting to a claim on the basis of any language, 'functional' or otherwise, beyond what is already sanctioned by the provisions of 35 U.S.C. § 112.

*In re Swinehart, et al., supra* at 213.

*In re Venezia*, 530 F.2d 956, 959 (CCPA 1976) in interpreting the claim language "each sleeve of said pair adapted to be fitted over the insulating jacket of one of said cables", said "[r]ather than being a mere direction of activities to take place in the future, this language imparts a structural limitation to the sleeve. Each sleeve is so structured or dimensional that it can be fitted over the insulating jacket of a cable. A similar situation exists with respect to this 'adapted to be affixed' and 'adapted to be positioned' limitations in the third and fourth paragraphs of the claim." This case is cited in *MPEP 2173.05(g)* as is the above-discussed *Swinehart* case.

That section of the MPEP reads, in part, as follows:

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure of specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971) ...

It was held that the limitation used to define a radical on a chemical compound as "incapable of forming a dye with said oxidizing developing agent" although functional, was perfectly acceptable because it set definite boundaries of the patent protection sought. *In re Barr*, 444 F.2d 588, 170 USPQ 33 (CCPA 1971).

In a claim that was directed to a kit of component parts capable of being assembled, the Court held that limitation such as "members adapted to be positioned" and "portions ... being resiliently dilatable whereby said housing may be slidably positioned" served to precisely define present structural attributes of interrelated

component parts of the claimed assembly. *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976).

The claims at issue are also not directed to a “new intended use of an old product.” Thus, the holding and the logic of *In re Schreiber*, 128 F3d. 1473, 44 USPQ2d 1429 (Fed. Cir. 1997) do not apply. *Schreiber* held that “[t]he recitation of a new intended use of an old product does not make a claim to that old product patentable.” The main claim at issue in *Schreiber* was:

[a] dispensing top for passing only several kernels of a popped popcorn at a time from an open-ended container filled with popped corn, having a generally conical shape and an opening at each end, the opening at the reduced end allows several kernels of popped popcorn to pass through at the same time, and means at the enlarged end of the top to embrace the open end of the container, the taper of the top being uniform and such as to by itself jam up the popped popcorn before the end of the cone and permit the dispensing of only a few kernels at a shake of a package when the top is mounted on the container.” (Emphasis added)

The Federal Circuit in *Schreiber* affirmed the finding of the Patent Office that an attachment to an oil can as disclosed in a prior art patent could structurally be used to dispense popped popcorn as described in the above claim. The examiner’s finding to that effect established a *prima facie* case of anticipation, and the applicant did not meet his burden then of showing that the “prior art structure did not inherently possess the functionally defined limitations of his claimed apparatus.”

The claim language at issue here is not directed to and does not concern an intended use of the claimed sheet structure. For example, the claim language at issue herein is not for a “sheet structure for use in business transactions” as mentioned above nor is it a “sheet structure capable of covering a window” or a “sheet structure adapted to be placed on a table.” Rather it concerns and defines structural properties of the elements of the sheet structure. For example, splitting when folded is *not* an intended use of the sheet structure, but rather is a structural property of the sheet structure. That is, if Examiner Ahmad is contending that the intended use of the subject sheet structure is “bending” or that the intended use is “splitting, then Applicant respectfully submits that

that contention is incorrect. Rather, the claim language at issue is a structural feature or limitation of the claimed structure. This is explained in detail in the section above entitled "Examiner Ahmad's Claim Construction Technique is Improper."

In *Computer Docking Station Corporation v. Dell, Inc., et al.*, 2007-1169, -1316 (Fed. Cir. 03/21/2008) it was held that the terms "portable computer" and "portable computer microprocessing system," as used in the preambles of the asserted claims limited the scope of the claims.

Accordingly, Examiner Ahmad's claim construction technique is improper and all of the claim terms are positive limitations which are to be accorded patentable weight. If the subject rejections are repeated, Applicant requests that the Examiner identify the cases which are being relied upon and provide an analysis thereof.

***B. Examiner Ahmad's Technique is Contrary to PTO Board Decisions***

The following are examples of recent opinions of the Board of Patent Appeals and Interferences ("Board") on this point. While each of these opinions is not written for publication and is not binding precedent of the Board, they are instructive as to how the Board interprets claim language very similar to that at issue here. It can be seen that the Board does not use Examiner Ahmad's "technique," but rather considers all similar claim language as introducing positive limitations.

(1) *Ex parte Beigel, et al.*, Appeal No. 2005-0171, Paper No. 11. The examiner therein contended that "false-sync sequences" language in the preamble was not a positive limitation. The Board disagreed and said that "[t]he 'false-sync sequence' language is indeed a positive limitation since it establishes conditions and an environment in which the claimed data sequence and preamble identifying functions must operate." The Board further disagreed with the examiner's contention

that this "language can be given no patentable weight since such language appears only in the claim preamble and merely recites the intended use of a structure."

(2) *Ex parte Calhoun, et al.*, Appeal No. 2003-1599, Paper No. 17. Claim language "sized and configured" was held to be a positive structural limitation.

(3) *Ex parte Miller, et al.*, Appeal No. 97 -0972, Paper No. 13, pages 6-7, "[t]he various functional limitations in the claims (*e.g.*, that the elongated member is 'adapted to extend between an armrest assembly and a set member' set forth a function which the apparatus must be structurally capable of performing (*see, e.g., In re Venezia*, 530 F.2d 956, 959, 189 USPQ 149, 151-52 (CCPA 1976)) and such a functional statement must be given full weight and may not be disregarded in evaluating the patentability of the claims (*see, e.g., Ex parte Bylund*, 217 USPQ 492, 498 (Bd. App. 1981))." That is, the Board said that such functional statements must be given full weight and may not be disregarded in evaluating the patentability.

(4) *Ex parte Prall*, Appeal No. 2003-1556, Paper No. 24. The phrase "the removable spacer layer...is adapted to be completely removed when isotropically etched" was held to impose a "capability requirement of part of the claimed semiconductor structure." It was therefore given patentable weight, by the Board, contrary to the Examiner's reliance on *In re Hutchinson, supra*.

(5) *Ex parte Brick*, Appeal No. 2000-1794, Paper No. 29. In reversing the Examiner's rejections of claims 1-11 and 13, the Board referred to *In re Swinehart, supra*, and said on page 5 that there is "nothing intrinsically wrong with the use of this ["adapted to be"] technique in drafting a patent claim." The Board said that this was contrary to the Examiner's arguments that "the recitation that an element is 'adapted to' perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re [Hutchison]*, 69 USPQ 138."



(6) *Ex parte Belisle, et al.*, Appeal No. 2002-2224, Paper No. 33. Claim language "such that the washer is removable from the shaft without breaking the washer or the shaft" was held to be a positive limitation in a patentable sense.

(7) *Ex parte Machida*, Appeal No. 1998-2826, Paper No. 13. Claim language "an elongated plate member adhesively bonded to a surface of a nail shell with an adhesive agent" was found to not be a statement of intended use. Rather, it was held to be "a positive limitation which cannot be ignored in applying prior art."

(8) *Ex parte Ligler, et al.*, Appeal No. 1999-1384, Paper No. 15. Claim language that "the membrane may be rinsed and said device may be reused" was found to further limit the claimed device so that it is to reusable.

(9) *Ex parte Beckage*, Appeal No. 2003-0242, Paper No. 13. The examiner, citing *In re Hutchinson, supra*, contended that terminology that an element is "adapted to" perform a function is not a positive limitation in any patentable sense. The Board disagreed and reversed the examiner. Citing *In re Venezia, supra*, the Board said that "the scope of the claims can be ascertained with a reasonable degree of precision and particularity."

Accordingly, Examiner Ahmad's claim construction technique is improper and all of the claim terms are positive limitations which are to be accorded patentable weight.

**C. Examiner Ahmad's Technique is Contrary to MPEP 2111.04**

Examiner Ahmad's claim construction technique is contrary to *MPEP 2111.04*, which is set forth below.

Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are:

- (A) "adapted to" or "adapted for" clauses;
- (B) "wherein" clauses; and
- (C) "whereby" clauses.

The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a "'whereby' clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention." *Id.* However, the court noted (quoting *Minton v. Nat'l Ass'n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)) that a "whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited." *Id.*<

As set forth earlier in the present paper, whether such clauses are limitations depends on the specific facts of the case; and the present facts justify treating them as limitations. Also, Examiner Ahmad has not provided any discussion of the specific facts or why the specific facts of this case require the clauses to not be limitations.

This MPEP section then relies upon and cites two cases, the below-discussed *Hoffer* and *Minton* cases. Careful examination of these cases shows that *MPEP 2111.04* does not impose any limiting effect on the words/clauses/phrases at issue in the claims in this patent application.

*Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329 (Fed. Cir. 2005) says that when "a 'whereby' clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention." That is precisely what the Examiner Ahmad has done in the present Final Rejection, that is, he has ignored conditions material to patentability.

The claim at issue in *Minton v. Nat'l Ass'n of Securities Dealers, Inc.*, 336 F.3d 1373 (Fed. Cir. 2003) was a method claim ("a method for trading securities between individuals") and the clause at issue was "executing a trade of the security ... whereby the security is traded efficiently between the first individual and the second individual." No weight was given to the "traded efficiently"

phrase because a "whereby clause is not given weight when it simply expresses the intended result of a process step positively recited" (emphasis added) and is a laudatory phrase characterizing the result. Clearly, the *Minton* case does not apply to the facts in the present application.

Accordingly, Examiner Ahmad's claim construction technique is improper and all of the claim terms are positive limitations which are to be accorded patentable weight. Examiner Ahmad has provided no analysis of why the specific facts of this case require that the phrases at issue should not be treated as limitations despite the fact that Applicant has provided in Dr. Ugolick's Declaration analysis as to why they should be treated as limitations.

***D. Examiner Ahmad's Technique is Contrary to Practice by Other USPTO Examiners***

As explained above, Examiner Ahmad has taken the position that "being constructed and adapted to cause..." "being selected and constructed, and the ...being configured, such that ..." and "... being structurally capable of causing ..." "and similar phrases in any and all claims are "intended use, non-positive limitations" and therefore not to be accorded any patentable weight. Such an interpretation is contrary not only to the law as explained above but also to the practice by other USPTO patent examiners.

The following are examples of recent patents generated in a quick word search by counsel wherein the Primary Examiner is listed as ***Rena Dye*** (who is the new Examiner in the present application) and: (a) the phrase "adapted to" is used in one or more claims in U.S. Patent 6,607,800 "the transfer layer being ***adapted to*** be attached to the container during use conditions" (claim 1); (b) the phrase "capable of" is used in one or more claims of U.S. Patent 7,300,688 "having regions ***capable of*** aligning the liquid crystal material in a first alignment" (claim 1), and U.S. Patent 7,157,128 "the substrate is formed to be ***capable of*** transmitting the laser beam therethrough" (claims 9 and 10); (c) the phrase "constructed to" is used in one or more claims in U.S. Patent 6,916,521 "a cleaning layer ***constructed to*** remove debris from a recording head as it slides along the

head” (claim 1); (d) the phrase “configured so that” is used in one or more claims of U.S. Patent 7,297,377 “the liquid crystal display device is *configured so that* a response time between a lowest brightness level and a highest brightness level is less than 16.7 ms”(claim 1); and (e) the phrase “configured such that” is used in one or more claims of U.S. Patent 7,157,128 “the optical information recording medium being *configured such that* the record data can be recorded and reproduced by irradiation of the laser beam to said recording layer from a substrate side” (independent claim 9).

Accordingly, all of the features/phrases/clauses/terms at issue herein are positive limitations and must be accorded patentable weight in the further examination of this application. When they are accorded patentable weight it is clear that the claims are not anticipated by and patentably distinguish over *Mihara*, at least for reasons set forth in Dr. Ugolick’s Declaration.

### ***Policy of Compact Prosecution***

Examiner Ahmad rejected claims in copending related application Serial No. 11/134,724 as being unpatentable over U.S. Patent 5,275,868 (Popat). It is assumed that the claims in the present application are patentable over *Popat* since no (alternative) rejections of the claims over *Popat* have been made.

### ***Conclusions***

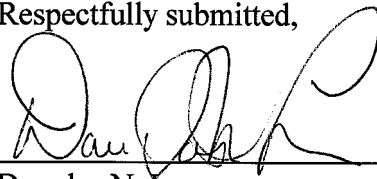
In view of the above, it is respectfully submitted that the claims were improperly construed. When properly construed the claims patentably distinguish over *Mihara*. Accordingly the present application is in condition for allowance. Issuance of the Notice of Allowance at an early date is in order and is respectfully solicited.

Examiner Dye is invited to call the undersigned counsel for Applicant at counsel's new phone number ((805) 230-1350 ext. 244) to answer any questions or to discuss steps necessary for placing this application, which has been pending for more than seven years, in condition for allowance.

The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 503456. Should such additional fees be associated with an extension of time, Applicant respectfully requests that this paper be considered a petition therefor.

Date: April 11, 2008

Respectfully submitted,

  
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